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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the U.S. Application of

Michael F. QUINN et al.

U.S. Serial No. 08/626,600

Filed: April 2, 1996

For: DOCUMENT STORAGE AND RETRIEVAL SYSTEM (As Amended)

BOX AF

Assistant Commissioner For Patents
Washington, D.C. 20231



Group Art Unit: 2761

Examiner: Hughet, W.

PATENT

GROUP 2700

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RESERVED

REPLY BRIEF PURSUANT TO 37 C.F.R. § 1.193(b)

Sir:

Responsive to the Examiner's Answer mailed January 4, 1999, please enter the following Reply Brief. It should be noted that this Reply Brief is being filed before a decision has been reached by the Petitions Branch regarding Applicant's Petition to Reopen Prosecution. Given the prospective time frame of not receiving a decision within the next month, yet still having a burden to petition for extended time periods to file a Reply Brief, Applicant is hereby filing this Reply Brief at this time to avoid incurring costs of additional petitions for extensions of time. It follows that this Reply Brief is prepared from the perspective that it will be considered only should the Petitions Branch deny the petition.

**The Examiner Erroneously Equates What Is Taught In The
Specification With Claim Limitations**

In paragraph 6 spanning pages 5 and 6 of Paper #15, the Examiner equates some phrases in the specification of the present invention with some phrases from Cukor's specification and concludes that

the claims are therefore not allowable, citing to *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (BNA) (Fed. Cir. 1994) for support.

Epstein does not stand for the proposition that if two specifications are equal, then by default the two sets of claims are equal and therefore unallowable. Applicants respectfully assert that patentably over the prior art is determined by the language in the claims as compared to what is taught in the prior art and is not based upon some comparison of the specification with language in a prior art patent specification.

The Examiner Is Unclear With Respect To Cukor

Applications respectfully submit that the Examiner contradicts himself regarding what is disclosed in the Cukor reference. This contradiction shows that the reference does not expressly teach certain features as alleged by the Examiner and provide a confusing record to which it is difficult for the Applicants to respond.

For instance, the Examiner states in paragraph 7 of Paper #15:

[W]hile Cukor does not expressly disclose use of a wide area network for connecting the workstations to the regional centers nor for linking regional centers to each other, it does teach that a plurality of such regional centers may be networked together over a large geographic area. See Cukor at Col 5, lines 52-59. (emphasis added).

Applicants respectfully assert that the first half of this phrase is completely contradictory with the second half. Applicants are at a loss as to how Cukor can admittedly fail to disclose either use of a wide area network or linking regional centers, yet teach networking regional centers.

Apparently, the Examiner believes that there is a difference between the phrase “wide area network” and “networked together over a large geographic area.” Applicants respectfully assert that the only difference between these phrases is in language and not in meaning. Applicants have never argued this difference nor do they care to do so now. Instead, Applicants merely point out that nowhere in col 5, lines 52-59 of Cukor, is it stated that the several central processing stations are

networked together. Rather, the cited passage clearly states that there may be several central processing stations, where each central processing station is networked with several remote processing stations. While the patent of Cukor may support allowing one remote processing station to share information with another remote processing station via a central processing, Applicants respectfully submit that Cukor does not teach or suggest central processing stations networked together.

**The Examiner Fails To Take Into Account The Fact That Applicants
Use The Word "Message" Differently From Cukor**

The Examiner cites to col. 21 - col. 22, line 11 of the Cukor reference in paragraph 8, page 7 of Paper #15. What the Examiner fails to notice is that Cukor provides a definition for the word "message" in col. 21, lines 13-16, stating

[A] variety of **messages** are transported over each link. These **messages** include the **transmission of images** for archiving and for printing . . . (emphasis added)

This statement indicates that Cukor uses the word "message" to mean transport of a bundle of data over a network. This is not a message from one user of the present invention to another as defined in the specification. A message according to the present invention connotes, for example, readable text for a user, which is important, for example, for defining a folder according to the present invention.

The Examiner Improperly Relies Upon And Refers To Cukor's "Header"

In paragraph 10, on page 7 of Paper #15, the Examiner states "nowhere in the prior office actions was the 'header' of Cukor referenced or relied upon." Applicants respectfully assert that the Examiner has improperly relied upon Cukor's header as being equivalent to a message and a completed inquiry. In fact, the Cukor header cannot serve as either a message or a completed inquiry, nor does the header contain a message or a completed inquiry. In paragraph 7 on page 3 of Paper #12, the Examiner refers to col. 10, lines 22-40 of Cukor, which begins:

As the bills of lading are scanned, a key operator enters certain preliminary data into a **header record**" (emphasis added).

Clearly the Examiner does refer to a citation in the Cukor reference that describes the header and then goes on to use that citation to support a rejection in contradiction to the Examiner's position taken in Paper #15.

**The Examiner Vacillates On What Cukor Does Teach And What
Would Be Obvious To Add To Cukor**

In paragraph 8 on page 7 of Paper #15, the Examiner asserts:

[I]t would have been obvious to one of ordinary skill in the art of financial information management to include means for storing customer messages and inquiries.

The Examiner is therefore implicitly admitting that Cukor does **not** have a means for storing customer messages and inquiries by asserting such a feature would have been obvious to add to Cukor.

In paragraph 11, spanning pages 7 and 8 of Paper #15, the Examiner then asserts:

Such means [for storing transaction folders that contain bit mapped images and messages and completed inquiries] are disclosed by Cukor at Col. 5, lines 31-59; Col. 10, lines 22-40; and Col. 21, line 13 - col 22, line 11.

Applicants respectfully assert the Examiner is inconsistent in what he sets forth to be taught or suggested in Cukor.

The Manual of Patent Examiner Procedures Is Not Binding Precedent

In paragraph 14 on page 8 of Paper #15, the Examiner cites to MPEP § 2144.03 and asserts that Applicants are estopped from arguing the limitations related to the claimed supervisory features. Upon review of *In re Chevenard*, 139 F.2d 711 (CCPA 1943), Applicants respectfully assert that either MPEP § 2144.03 misapplies the holding of *Chevenard* or the Examiner has misapplied MPEP § 2144.03. The Court in *Cleveland* only required that the Applicant raise any issues pertaining to the

Examiner's rejection in front of the Examiner before raising these issues for the first time with a court. The Court did not mandate that the Applicant be required to raise any objections in the very next Office Action, as the Examiner is asserting, is set forth in the MPEP. Since Applicants are raising the issues before the Examiner in the Appeal Brief, to which the Examiner may respond to in his Examiner's Answer, it follows that the Applicants have complied with the broad holding of the court in *Chevenard*.

Conclusion

For all of the above reasons, it is respectfully submitted that the claims are patentably distinguishable from the prior art of record. Accordingly, Applicants respectfully request that the Board of Appeals Reverse the Examiner's rejection and that the case is subsequently passed to issue.

Respectfully submitted,

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Date: 4/2/99

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